

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

LUCKY BREAK WISHBONE
CORPORATION,

Plaintiff,

v.

SEARS, ROEBUCK AND CO., a New York
corporation, and YOUNG AND RUBICAM
INC., a Delaware corporation,

Defendants.

No. C06-312Z

ORDER

This matter comes before the Court on the deferred portions of Plaintiff's Combined Motion for Partial Summary Judgment on Issues of: (1) Originality; (2) Damages; and (3) Standing and Affirmative Defenses, docket no. 84, and Defendants' Motion for Summary Judgment, docket no. 87. After hearing oral argument on October 26, 2007, the Court GRANTED IN PART, DENIED IN PART, and DEFERRED IN PART Plaintiff's Motion for Partial Summary Judgment, docket no. 84. Minutes, docket no. 135. The Court GRANTED Plaintiff's summary judgment motion on the issues of standing and fraud, DENIED on the issue of damages, and DEFERRED on the issue of originality. The Court also DENIED IN PART and DEFERRED IN PART Defendants' Motion for Summary Judgment, docket no. 87. The Court DENIED Defendants' summary judgment motion on

1 the issue of standing and DEFERRED on the issues of originality and copying and on the
2 issue of whether Defendant Young and Rubicam, Inc. should be dismissed.

3 The Court now enters the following Order on the deferred portions of the cross-
4 motions for summary judgment regarding Lucky Break Wishbone Corporation's ("Lucky
5 Break") copyright infringement claim based on the Lucky Break Wishbone, as alleged
6 against Defendants Sears, Roebuck and Co. ("Sears") and Young & Rubicam ("Y&R"). See
7 Am. Compl., docket no. 31, ¶¶ 27-28.¹ For the reasons outlined below, the Court holds the
8 Lucky Break Wishbone was independently created by Mr. Hillesland and contains the
9 minimal degree of creativity required to demonstrate originality. The design of the Lucky
10 Break Wishbone incorporates sculptural features that can be identified separately from, and
11 are capable of existing independently of, the utilitarian aspects of the article. Accordingly,
12 the Court GRANTS Plaintiff's motion, and DENIES Defendants' motion, on the issues of
13 originality and utility, and holds that Lucky Break owns a valid copyright in the Lucky Break
14 Wishbone.

15 On the issue of access, the Court GRANTS IN PART and DENIES IN PART
16 Defendants' summary judgment motion. The Court GRANTS IN PART Defendants' motion
17 on the issue of access and DISMISSES IN PART Lucky Break's copyright infringement

18
19 ¹ After the parties' cross-motions were filed and fully briefed, Plaintiff filed a Motion for
20 Leave to Amend Complaint, docket no. 121. On October 26, 2007, the Court heard oral
21 argument and granted Plaintiff's Motion for Leave to Amend Complaint. Minutes, docket
22 no. 135. Accordingly, on November 2, 2007, Plaintiff filed its Second Amended Complaint,
23 docket no. 136, alleging two copyright infringement claims. Plaintiff's first copyright
24 infringement claim in the Second Amended Complaint alleges copying of the Lucky Break
25 wishbone sculpture, see Second Am. Compl. ¶¶ 29-30, and Plaintiff's second copyright
26 infringement claim in the Second Amended Complaint alleges copying of the Lucky Break
wishbone product warning, see Second Am. Compl. ¶¶ 31-32. Although the parties' cross-
motions for summary judgment related to the copyright infringement claim in the First
Amended Complaint, the first copyright infringement claim alleged in the Second Amended
Complaint is identical to the copyright infringement claim alleged in the First Amended
Complaint. As a result, this Order addresses the first copyright infringement claim in the
Second Amended Complaint.

1 claim – to the extent Lucky Break alleges that Defendants had access to the *production*
2 wishbone. The Court DENIES IN PART Defendants’ motion and holds that Lucky Break’s
3 copyright infringement claim survives summary judgment – to the extent Lucky Break
4 alleges that Defendants had access to the *prototype* wishbone.

5 On the issue of whether the Sears Wishbone and the wishbone image in the Sears
6 Circular are virtually identical to the Lucky Break Wishbone, the Court STRIKES IN PART
7 and DENIES IN PART Defendants’ motion. The Court STRIKES IN PART the motion as it
8 relates to the Lucky Break production wishbone. The Court DENIES IN PART the motion
9 as it relates to the Lucky Break prototype wishbone because of genuine issues of material
10 fact.

11 On the issue of Y&R’s infringement, the Court GRANTS Defendants’ summary
12 judgment motion and DISMISSES Lucky Break’s copyright infringement claim as alleged
13 against Y&R in the Second Amended Complaint, ¶¶ 29-30.

14 **BACKGROUND**

15 **The Natural Wishbone Model for the Lucky Break Wishbone Sculpture**

16 Lucky Break’s founder, Ken Ahroni, conceived of a mass-produced plastic breakable turkey
17 wishbone during Thanksgiving in November 1999, and he kept the wishbone from his
18 Thanksgiving turkey (the “natural wishbone”) to use as a model. Walters Decl., docket no.
19 86, Ex. H (Ahroni Dep.) at 10:22-24, 12:8-11, 13:10-18; Rachman Resp. Decl., docket no.
20 101, Ex. 16 (Interrog. No. 4) at 11-12. In December 2003, Mr. Ahroni took the natural
21 wishbone to Cimtech, Inc. (“Cimtech”), which, in turn, used 3-D design and manufacturing
22 software to collect basic structure data of the natural wishbone for use in manufacturing.
23 Walters Decl., Ex. H (Ahroni Dep.) at 23:9-11 and Ahroni Dep. Ex. D-1; *id.*, Ex. F (Kidd
24 Dep.) at 8:3-9:18, 11:3-5, 13:1-9, 31:2-8. Cimtech did not make any decisions of how the
25 plastic wishbone would be molded. *Id.*, Ex. F (Kidd Dep.) at 13:4-5.

1 **Lucky Break's Prototype Wishbone**

2 In December 2003 and January 2004, Dale E. Hillesland of Paraflex, Inc. ("Paraflex")
3 used Cimtech's data to design and create a "prototype" plastic wishbone for Lucky Break.
4 Walters Decl., Ex. H (Ahroni Dep.) at 23:11-18; Rachman Decl., docket no. 92, Ex. 4
5 (Hillesland Dep.) at 23:4-15, 25:10-20, 26:13-16, 51:19-22; Hillesland Decl., docket no. 108,
6 ¶ 12. Mr. Hillesland spent approximately 65 hours making the prototype mold which was
7 used to make the Lucky Break prototype wishbone. Rachman Decl., Ex. 4 (Hillesland Dep.)
8 at 25:21-25. The prototype mold was completed by January 27, 2004. Id., Ex. 4 (Hillesland
9 Dep.) at 26:4-16.

10 Mr. Hillesland created the prototype wishbone according to the following process.
11 First, Mr. Hillesland used the Cimtech data to make a computer model of the wishbone.
12 Hillesland Decl. ¶ 4. Because Cimtech provided data for only half of the wishbone, Mr.
13 Hillesland used a software program to create a mirror-image of the other half of the
14 wishbone in the model. Id.; Rachman Decl., Ex. 4 (Hillesland Dep.) at 23:4-9, 29:18-30:6.
15 Second, Mr. Hillesland used the software to select a suitable parting line, which is "the area
16 within a mold block perimeter where the two halves of the mold will separate." Hillesland
17 Decl. ¶ 5. Mr. Hillesland made two alterations to hide the parting line, changes which were
18 made "solely for aesthetic or artistic reasons." Id. Third, Mr. Hillesland used the software to
19 cut electrodes out of graphite. Id. ¶ 6; Rachman Decl., Ex. 4 (Hillesland Dep.) at 32:17-21,
20 37:14-18. Mr. Hillesland had to choose paths and angles for cutting out the electrodes.
21 Hillesland Decl. ¶ 6. "Electrodes are three dimensional shapes that are cut from graphite
22 using a computer-aided cutting system; they were the first crude likenesses of the wishbone
23 sculpture." Id. Each of the two graphite electrodes represents one half of a wishbone.
24 Rachman Decl., Ex. 4 (Hillesland Dep.) at 33:24-34:4. Fourth, after the electrodes were cut,
25 Mr. Hillesland made many alterations to them manually. Hillesland Decl. ¶ 7; Rachman
26 Decl., Ex. 4 (Hillesland Dep.) at 37:19-21 (referring to "hand-finishing" of the electrodes).

1 Fifth, the graphite electrodes were “used as conductors of electricity to burn the mold shapes
2 into metal blocks so the injection molds [could] be created.” Hillesland Decl. ¶ 6.

3 **Lucky Break’s Production Wishbone**

4 “Once Lucky Break signed off on the look of the prototype wishbone design, [Mr.
5 Hillesland’s] intent was to deliver the same look in the Lucky Break Wishbones that came
6 out of the final production molds.” Hillesland Decl. ¶ 12. Mr. Hillesland started working on
7 the final production mold in June 2005, and completed work on it by the end of September
8 2005. Rachman Decl., Ex. 4 (Hillesland Dep.) at 51:23-52:19. In making the production
9 mold, Mr. Hillesland used the same data set and “the same cutter paths for the electrodes” as
10 he used for the prototype mold. *Id.*, Ex. 4 (Hillesland Dep.) at 41:24-42:4; Hillesland Decl.
11 ¶ 12. He created two new graphite electrodes for the production mold, separate from the
12 graphite electrodes for the prototype mold. Rachman Decl., Ex. 4 (Hillesland Dep.) at 35:1-
13 10, 37:3-7. The graphite electrodes for the production mold have been submitted into the
14 record on summary judgment. *Id.*, Ex. 4 (Hillesland Dep.) at 32:17-21, 33:24-34:4
15 (describing D-42 and D-43 Exhibits to the Hillesland Dep.).

16 **Mr. Hillesland’s Hand-Finishing of the Graphite Electrodes**

17 As noted above, Mr. Hillesland “hand-finished” the graphite electrodes to make the
18 molds for the wishbones, and he used the same data set and the same cutter paths to make
19 graphite electrodes for the production mold as for the prototype mold. Specifically, Mr.
20 Hillesland testified with respect to the hand-finishing on the *prototype* graphite electrodes:

21 Q: Do you remember what you did?

22 A: Basically the same things as I did on the other one [i.e., the production
23 graphite electrodes]. I round out the end a little bit. I reduce some of
24 this area in the center of the electrode, and on the two tips out there, I,
25 on one side of it, I did some sanding to reduce the shape on that where it
26 was kind of bulging out a little bit. I went in and gave it a little file with
some sandpaper. Any real sharp edges on there, I don’t remember how
many I did at the time, but I go in and I knock down the little things . . .

1 Rachman Decl., Ex. 4 (Hillesland Dep.) at 37:22-38:7. With respect to the hand-finishing on
2 the *production* graphite electrodes, Mr. Hillesland testified that he made “five to six”
3 changes from the natural wishbone, including rounding out the head, reducing some area in
4 the center to knock down a high spot, smoothing the outside edges, sanding the ends of the
5 arms, thinning the arm, and breaking the edge. Id., Ex. 4 (Hillesland Dep.) at 43:3-48:7.

6 After describing the five to six changes he made to the production graphite electrodes,
7 he testified that he did the same hand-finishing on the prototype graphite electrodes, but he
8 also admitted there could be some variations in what he did:

9
10 Q: Do you think you did the same things to the prototype?

11 A: Yes.

12 Q: But there could be variations between the –

13 A: Right.

14 Q: Let me finish the question. There could be variations to the extent of
15 what you did on the prototype versus what you did on the production
16 mold?

17 A: Yes.

18 Id., Ex. 4 (Hillesland Dep.) at 48:11-19.

19 He also admitted that he could not remember whether he had the prototype mold in
20 front of him when he made the production mold, and that there could be some resulting
21 differences between the prototype and production molds:

22 Q: And then the changes that were made after – from the data set you did by
23 hand?

24 A: Yes.

25 Q: So how did you – did you have the prototype mold in front of you when you
26 made the changes to the graphite on the production mold?

A: I don’t remember.

Q: So do you know whether the hand changes you made on the production mold
are the same as the ones you made on the prototype mold?

A: I don't know.

Q: So there could be some differences between what you changed on the graphite electrodes for the prototype versus the graphite electrodes –

A: There could be.

Q: Okay. And how would that – would that show up in any way?

A: (No response.)

Q: Would it change the thickness, or would it change the appearance?

A: It may change some – there would be really, really subtle changes in it, as far as maybe the thickness on it.

Rachman Decl., Ex. 4 (Hillesland Dep.) at 42:5-43:2.

In his subsequent declaration, Mr. Hillesland states more equivocally: “I made the same manual alterations to the electrodes” for the production mold as for the prototype mold.

Hillesland Decl. ¶ 12. He further explains:

After nearly thirty years in the business, I am capable of filing and sanding electrodes to create the precise image I want. For this reason, I was able to ensure that the final Lucky Break Wishbones were effectively identical to the prototype Lucky Break Wishbones. The only meaningful difference in the appearance of the prototype and production Lucky Break Wishbones resulted from a slight adjustment in the height of the ejector pins, which made the ejector pins raised on the prototype Wishbones and recessed on the production Wishbones. To my mind, the prototype and production Lucky Break Wishbones are the same wishbone sculpture.

Id. In addition to the difference in the ejector pins, Mr. Hillesland also testified in his deposition that there is a “slight variation” in the parting line between the prototype and production molds, and that this change reduced the thickness of the width of the production wishbone as compared to the prototype wishbone. Rachman Decl., Ex. 4 (Hillesland Dep.) at 40:4-41:11, 49:8-10, 50:12-51:18. Mr. Ahroni testified in his deposition that the prototype and production wishbones have “a slight difference in the inside of the V where the gating of the wishbone is.” Id., Ex. 2 (Ahroni Dep.) at 85:11-21.

1 **Artistic Intent**

2 Mr. Hillesland stated in his declaration that he “spent at least fifteen to twenty hours
3 shaping the electrodes so the molds would create nice-looking plastic wishbones.”
4 Hillesland Decl. ¶ 7. “[T]he manual alterations I made were to avoid sharp edges” and “to
5 create a smoother surface.” Id. The graphite electrodes were sanded and rounded to obtain
6 the desired shape, smoothness and look. Rachman Decl., Ex. 4 (Hillesland Dep.) at 32:17-
7 33:20, 37:14-21. Although some of Mr. Hillesland’s manual changes to the graphite
8 electrodes were for handling purposes (i.e., to make the wishbone smooth), other changes
9 were for aesthetic reasons. Id., Ex. 4 (Hillesland Dep.) at 44:3-16 (smoothing bump because
10 he “didn’t like the way it looked,” and not because it had any effect on making it an easier
11 mold to use or less expensive), at 46:2-4 (smoothing end because he “didn’t want it too blunt
12 looking”), and at 46:12-13 (he “want[ed] the thing to look a certain way”). Mr. Hillesland
13 testified that his hand-work was intended to “creat[e] a caricature of what I think a wishbone
14 . . . looks like,” and that he didn’t “really care at that point what [the natural wishbone]
15 look[ed] like anymore.” Id., Ex. 4 (Hillesland Dep.) at 46:19-24. When asked why he
16 rounded the head, he testified “[a]gain, cosmetics mostly.” Id., Ex. 4 (Hillesland Dep.) at
17 47:4-7. Mr. Hillesland stated in his declaration that “an infinite number of design options
18 concerning the specific shaping and contours of the Lucky Break Wishbone were available to
19 me within the general confines of manufacturing within plastic, so I was free to give the
20 Lucky Break Wishbone the artistic look I wanted to achieve.” Hillesland Decl. ¶ 9. Mr.
21 Hillesland made changes because he “was concerned with the aesthetic appearance of the
22 final wishbone” and he wanted to achieve “a sleek, smooth, stylized wishbone sculpture.”
23 Id. ¶¶ 7, 8. He “spent significant effort to achieve that look at all stages of the molding
24 process.” Id. ¶ 8.

25
26

Expert Testimony Regarding Differences Between Lucky Break's Production

Wishbone and the Natural Wishbone

Lucky Break's expert on plastics engineering, Axel Sommer, has identified eleven features that distinguish Lucky Break's production wishbone from the natural wishbone. Rachman Decl., Ex. 32 (Mr. Sommer's Expert Report) at 7-11. Lucky Break's expert in avian anatomy, Dr. David Steadman, has identified seven features of the production wishbone "that are of distinctly human origin or design." Steadman Decl., docket no. 63, Ex. A (Dr. Steadman's Expert Report), at 5-7. Dr. Steadman states that these features "are not 'standard' elements of [] furcula² nor are they 'indispensable' to the realistic expression of [] furcula." *Id.*, Ex. A, at 7.

Copyright Registration

Lucky Break registered the "Lucky Break Wishbone" sculpture with the United States Copyright Office as Reg. No. VA 1-325-348 ("the '348 Registration"). Rachman Decl., Ex. 26 (Certificate of Registration); Ahroni Decl., docket no. 66, ¶¶ 2, 3, Ex. A (Lucky Break's application and deposit materials). Lucky Break represented on its application for copyright registration that "2004" was the "Year in Which Creation of This Work Was Completed," *see* Ahroni Decl., Ex. A, which was the year that the prototype wishbone was completed, and not the year the production wishbone was completed.

Defendants contend that Lucky Break only deposited a photocopy³ of Lucky Break's production wishbone, and not Lucky Break's prototype wishbone, with the U.S. Copyright Office in connection with the application for copyright registration. Defs.' Mot., docket no.

² Dr. Steadman does not define furcula. The dictionary defines "furcula" as the plural form of "furculum," which is synonymous with "wishbone." Webster's Third New International Dictionary at 923 (1981).

³ For sculptural works, the U.S. Copyright Office instructs copyright registrants to provide two-dimensional "identifying material" and does not accept physical samples. Walters Decl., Ex. L. at 2.

87, at 11 (citing Rachman Decl., docket no. 92, Ex. 2 (Ahroni Dep.) at 101:3-102:23 and Exs. 27, 30 and 42). Contrary to Defendants' assertion, the evidence is not "clear" that Lucky Break's deposit was a copy of the production wishbone. The first piece of evidence relied upon is Mr. Ahroni's deposition. Defendants argue that Mr. Ahroni "admitted" that Lucky Break registered the production wishbone; however, a close look at Mr. Ahroni's deposition reveals no such "admission." In the excerpt relied upon by Defendants, Mr. Ahroni merely states that any wishbones created in December 2005 – i.e., at the time Lucky Break applied for copyright registration – would have been made from the production mold, and not the prototype mold. There is no follow-up testimony, however, that the deposit was a copy of a wishbone created in December 2005. Mr. Ahroni "can't tell" whether the wishbone in Exhibit D-12 was created with the prototype mold or the production mold, but he "assumes" it was made from the production mold. Rachman Decl., Ex. 2 (Ahroni Dep.) at 102:15-23; Walters Decl., Ex. H, at 137 (Ex. D-12). The second piece of evidence relied upon by Defendants is Exhibit 27 to the Rachman Declaration, which is a copy of Plaintiff's deposit showing three wishbone images, and is labeled Hillesland Deposition Exhibit D-45. Rachman Decl. ¶ 28. Mr. Hillesland testified about Exhibit D-45 as follows:

Q: Looking at these images on D-45, can you tell whether these are images of a wishbone from a production mold versus the prototype mold?

A: (No response.)

Q: I can focus your attention on the first, the left-hand image where you see the ejector pin markings.

A: My best feeling would be it's the production mold. I'll go with that.

Q: And what are you basing that on?

A: Maybe the ejector pins. Maybe the lines, where the parting line is, too. Yeah.

Id., Ex. 4 (Hillesland Dep.) at 72:23-73:9. The third and fourth pieces of evidence relied upon by Defendants are Exhibits 30 and 42 to the Rachman Declaration, which are pictures

1 of the production wishbones and prototype wishbones, respectively. Despite any
2 deficiencies in this evidence, Lucky Break has not contested the fact that the deposit was a
3 copy of the production wishbone. This issue may be important to the Court's jurisdiction
4 over Lucky Break's copyright infringement claim, as discussed in this Order at Footnote 10.

5
6 **The Sears "Wish Big" Promotion**

7 Y&R, an advertising agency, conceived of a wishbone giveaway and coupon
8 bounceback offer and introduced the idea to its client, Sears. Answer, docket no. 33, ¶ 13;
9 Rachman Decl., Ex. 7 (Katz Dep.) at 42:18-21. When Y&R commenced negotiations with
10 Lucky Break over the possible purchase of Lucky Break's wishbones, Lucky Break's
11 President, Mr. Ahroni, was aware that Y&R was acting on behalf of Sears. Rachman Decl.,
12 Ex. 2 (Ahroni Dep.) at 189:16-190:8. Lucky Break provided fifty wishbones to Y&R on
13 June 20, 2005, and two blue wishbones to Y&R on July 21, 2005. *Id.*, Ex. 2 (Ahroni Dep.)
14 at 80:10-24, 168:9-23, Ex. 6 (Navratil Dep.) at 52:23-53:18, Ex. 21 (Invoice to Y&R dated
15 June 20, 2005). Given this timing, the parties do not dispute that Lucky Break provided
16 Y&R with prototype wishbones, not production wishbones. Between July 5, 2005 and July
17 19, 2005, Y&R and Mr. Ahroni discussed the terms of a possible purchase of 1 to 2 million
18 Lucky Break wishbones. *Id.*, Ex. 20 (July 2005 emails between Y&R and Mr. Ahroni).
19 Y&R passed along Lucky Break's price estimate to Sears. *Id.*, Ex. 6 (Navratil Dep.) at 60:4-
20 6. In June or July 2005, Y&R presented physical samples of the Lucky Break prototype
21 wishbones to Sears. *Id.*, Ex. 6 (Navratil Dep.) at 62:9-12, 63:19-24, Ex. 7 (Katz Dep.) at
22 92:9-93:20. Lucky Break authorized Y&R's distribution of the sample wishbones and other
23 Lucky Break materials to Sears. *Id.*, Ex. 2 (Ahroni Dep.) at 163:5-16. Y&R recommended
24 that Sears use Lucky Break to provide wishbones for the promotion. *Id.*, Ex. 6 (Navratil
25 Dep.) at 67:12-16. At a date uncertain, Y&R became aware that Sears did not purchase
26

1 wishbones from Lucky Break, but, even then, Y&R did not know the identity of the other
2 vendor. Id., Ex. 6 (Navratil Dep.) at 72:23-73:16.

3 In or about late July 2005, Sears engaged Apex Products (“Apex”), an Illinois-based
4 trading company (not a party to this action), to procure the overseas manufacture of plastic
5 wishbones for Sears (the “Sears Wishbone”) in lieu of the Lucky Break wishbones. Id., Ex.
6 8 (Chiou Dep.) at 14:2-10, 16:6-17:7, 19:1-8, 25:15-27:14. Sears provided a Lucky Break
7 wishbone to Apex sometime in early- or mid-August. Id., Ex. 8 (Chiou Dep.) at 37:18-38:2,
8 39:18-40:1. Apex communicated with a manufacturer in China regarding the wishbone
9 project. Id., Ex. 8 (Chiou Dep.) at 41:11-14. Mr. Chiou of Apex testified that the Chinese
10 manufacturer used a real turkey wishbone upon which to base its original price estimate, and
11 used the Lucky Break wishbone only as a “size reference.” Id., Ex. 8 (Chiou Dep.) at 26:14-
12 18, 38:23-39:17, 105:4-7.

13 In or about June or July 2005, the ABD Group (“ABD”), another advertising agency
14 (also not a party to this action), began creating an advertisement for Sears (the “Sears
15 Circular”), for use in connection with a pre-Thanksgiving in-store promotional event that
16 was part of the Sears “Wish Big” holiday campaign. Id., Ex. 7 (Katz Dep.) at 50:18-24, Ex.
17 22 (ABD “Conference Report” dated July 12, 2005), Ex. 23 (Sears Circular showing a
18 wishbone in upper left corner on the first page). Sears provided a wishbone to ABD to be
19 photographed for use in the Sears Circular, but Sears’s Ms. Katz did not know whether it
20 was a Lucky Break wishbone or a wishbone provided by the Chinese manufacturer used by
21 Apex; she assumed it was a manufacturer’s production sample provided by Apex. Id., Ex. 7
22 (Katz Dep.) at 58:23–59:2, 60:2-24, 67:1-68:10, 69:2-70:5. Based on similar features, Mr.
23 Ahroni asserts that Lucky Break’s prototype wishbone was used to make the wishbone image
24 in the Sears Circular. Id., Ex. 2 (Ahroni Dep.) at 151:7-153:4.

25 Sears distributed the Sears Wishbones in Sears stores on November 19, 2005, to
26 customers making purchases on that date, while supplies lasted. Id., Ex. 7 (Katz Dep.) at

1 139:3-18; Ex. 23 (Sears Circular dated Nov. 19, 2005, stating: “Today Only, With Any
 2 Purchase, Get Your Wishbone and Get \$10 Off Your Next Purchase”). The cardboard
 3 topper that accompanied the Sears Wishbone included a coupon with which the customer
 4 could return between November 20, 2005 and November 23, 2005, and receive \$10 off a
 5 purchase of \$100 or more. Id., Ex. 24 (showing cardboard topper, atop the bag containing
 6 the Sears Wishbone). Y&R created the cardboard topper. Id., Ex. 6 (Navratil Dep.) at 71:5-
 7 72:9, Ex. 7 (Katz Dep.) at 42:22-43:6.

8 **DISCUSSION**

9 **A. Summary Judgment Standard**

10 Summary judgment is appropriate when the movant demonstrates that there is no
 11 genuine issue as to any material fact and that the moving party is entitled to judgment as a
 12 matter of law. FED. R. CIV. P. 56(c); Addisu v. Fred Meyer, Inc., 198 F.3d 1130, 1134 (9th
 13 Cir. 2000).

14 **B. Copyright Infringement**

15 “To establish [copyright] infringement, two elements must be proven: (1) ownership
 16 of a valid copyright, and (2) copying of constituent elements of the work that are original.”
 17 Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991).

18 **1. First Element of Copyright Infringement: Ownership of a Valid Copyright**

19 Under the Copyright Act, a plaintiff cannot maintain an infringement action until it
 20 has registered its work with the Copyright Office. 17 U.S.C. § 411(a) (“no action for
 21 infringement of the copyright in any United States work shall be instituted until
 22 preregistration⁴ or registration of the copyright claim has been made in accordance with this
 23 title”); Invision Media Servs., Inc. v. Glen J. Lerner, 175 Fed.Appx. 904, 907 (9th Cir. Apr.
 24 13, 2006) (17 U.S.C. § 411(a) is a “jurisdictional prerequisite”). “In order to obtain a
 25 copyright registration, an applicant must deposit as part of his application a ‘copy’ or

26 _____
⁴ Preregistration does not apply here. See 37 C.F.R. § 202.16.

1 ‘copies’ of the work, 17 U.S.C. § 408(b)(1) and (2),” and the Ninth Circuit has interpreted
 2 copies of the work to mean “bona fide copies of the original work,” and not
 3 “reconstructions.” Kodadek v. MTV Networks, Inc., 152 F.3d 1209, 1211 (9th Cir. 1998).
 4 Although “[c]opyright registration is not a prerequisite to a valid copyright,” Kodadek, 152
 5 F.3d at 1211,⁵ registration “is considered prima facie evidence of the validity of the
 6 copyright, which can be challenged by presenting evidence attacking the elements of a valid
 7 copyright, such as ownership, copyrightable subject matter, and originality.” Syntek
 8 Semiconductor Co. v. Microchip Tech. Inc., 307 F.3d 775, 781 (9th Cir. 2002); see also 17
 9 U.S.C. § 410(c). A certificate of copyright registration, therefore, “shifts to the defendant
 10 the burden to prove the invalidity of the plaintiff’s copyrights.” Entm’t Research Group, Inc.
 11 v. Genesis Creative Group, Inc., 122 F.3d 1211, 1217 (9th Cir. 1997). “An accused infringer
 12 can rebut this presumption of validity, however.” Id. “To rebut the presumption, an
 13 infringement defendant must simply offer some evidence or proof to dispute or deny the
 14 plaintiff’s prima facie case of infringement.” Id.

15 The Court accepts as true the undisputed fact that the deposit submitted with Lucky
 16 Break’s application for copyright registration was a copy of the production wishbone, and
 17 not the prototype wishbone. Thus, Lucky Break’s ‘348 Registration is prima facie evidence
 18 of the validity of Lucky Break’s copyright in the production wishbone, but is not prima facie
 19 evidence of the validity of Lucky Break’s copyright in the prototype wishbone. As the Court
 20 discusses below in connection with the issue of “access,” Lucky Break must prove that it has
 21 a valid copyright, and a valid copyright registration, in the *prototype* wishbone in order to
 22 succeed on its copyright infringement claim because Defendants had access only to the
 23 prototype wishbone. Because there is a question – that has yet to be addressed by the parties
 24 – as to whether Lucky Break has a valid copyright registration in the prototype wishbone,
 25 there is no presumption of validity of Lucky Break’s copyright in the prototype wishbone as

26 ⁵ See also 17 U.S.C. § 408(a) (“[R]egistration is not a condition of copyright protection”).

1 a result of the '348 Registration. The parties have cross-moved for summary judgment on
 2 two related issues⁶ addressing the validity of Lucky Break's copyright – originality and
 3 utility.⁷

4 **a. Validity (Originality) – Cross-Motions for Summary Judgment**

5 The Copyright Act protects “*original works of authorship* fixed in any tangible
 6 medium of expression, now known or later developed, from which they can be perceived,
 7 reproduced, or otherwise communicated, either directly or with the aid of a machine or
 8 device.” 17 U.S.C. § 102(a) (emphasis added). Thus, “[c]opyright protection subsists from
 9 the moment the work is ‘fixed in any tangible medium of expression.’” S.O.S., Inc. v.
 10 Payday, Inc., 886 F.2d 1081, 1085 (9th Cir. 1989) (quoting 17 U.S.C. § 102(a)). The
 11 Copyright Act does not extend protection “to any idea, procedure, process, system, method
 12 of operation, concept, principle, or discovery, regardless of the form in which it is described,
 13 explained, illustrated, or embodied in such work.” 17 U.S.C. § 102(b). Thus, Section 102(b)
 14 “makes only expression, not ideas, eligible for copyright protection.” Eldred v. Ashcroft,
 15 537 U.S. 186, 219 (2003). “[F]acts are not copyrightable” because “[t]he *sine qua non* of
 16 copyright is originality.” Feist, 499 U.S. at 345. “Original, as the term is used in copyright,
 17 means only that the work was independently created by the author (as opposed to copied
 18 from other works), and that it possesses at least some minimal degree of creativity.” Id. In

19
 20 ⁶ Defendants challenged Lucky Break's ownership of the copyright through their argument
 21 that Lucky Break lacked standing to sue for copyright infringement. After hearing oral
 22 argument, the Court held that Lucky Break owned the Lucky Break Wishbone copyright at
 23 the time of the alleged infringement in November 2005, and thus had standing to sue, based
 on a December 22, 2005 written memorialization of a January 2004 oral agreement to
 transfer all intellectual property rights from Paraflex to Lucky Break. Thus, the ownership
 issue is no longer before the Court.

24 ⁷ Defendants combine their originality and utility arguments, but they are appropriately dealt
 25 with as separate challenges to the validity of Lucky Break's copyright. See Superior Form
 26 Builders, Inc. v. Dan Chase Taxidermy Supply Co., 74 F.3d 488, 494 (4th Cir. 1996) (noting
 that utility focuses on whether a sculptural work is a “useful article” within the meaning of
 17 U.S.C. § 101).

1 Feist, the Supreme Court found originality lacking in the alphabetical arrangement of a
 2 telephone directory because alphabetical arrangement was “entirely typical” and the
 3 directory was “devoid of even the slightest trace of creativity.” Feist, 499 U.S. at 362.

4 **i. Independent Creation**

5 “Originality . . . means little more than a prohibition against actual copying.” North
 6 Coast Indus. v. Jason Maxwell, Inc., 972 F.2d 1031, 1033 (9th Cir. 1992) (citation and
 7 quotation omitted). “No matter how poor artistically the author’s addition, it is enough if it
 8 be his own.” Id. Defendants assert that Lucky Break’s copyright “is no more than a plastic
 9 reproduction of a naturally occurring item – a turkey wishbone.” Defs.’ Mot at 14 (citing
 10 Rachman Decl., Exs. 30, 41, 42 (photos of natural wishbone and of Lucky Break’s prototype
 11 and production wishbones)). These photos do not demonstrate that the Lucky Break
 12 Wishbone⁸ is an exact copy of a natural wishbone. While it is undisputed that a natural
 13 wishbone was used to provide the data set for the creation of the Lucky Break Wishbone, the
 14 use of “a matter in the public domain” upon which to base one’s work does not preclude
 15 originality. See, e.g., Kamar Int’l, Inc. v. Russ Berrie and Co., 657 F.2d 1059, 1061 (9th Cir.
 16 1981). In Kamar, the Ninth Circuit reversed summary judgment that toy animals lacked
 17 originality, reasoning that “[t]he mere fact that plaintiff used a matter in the public domain
 18 does not in and of itself preclude a finding of originality, since plaintiff may have added
 19 unique features to the matter so as to render it copyrightable.” Id. (citation omitted).

20 Paraflex’s Mr. Hillesland made artistic changes to the data set when making the
 21 computer model, and he subsequently made changes to the graphite electrodes used to create
 22 the Lucky Break Wishbone. See, e.g., Hillesland Decl. ¶¶ 5-7; Rachman Decl., Ex. 4
 23 (Hillesland Dep.) at 37-38, 43-48. Defendants do not challenge Mr. Hillesland’s testimony

24
 25 ⁸ For the purposes of this discussion of originality and utility, the term “Lucky Break
 26 Wishbone” refers to both the prototype wishbone and the production wishbone. Thus, the
 Court’s conclusions with respect to originality and utility apply to both the prototype and
 production wishbones.

1 that he made changes to the data set to create the computer model, and they admit that Mr.
 2 Hillesland made changes to the graphite electrodes used to create the injection mold for the
 3 Lucky Break Wishbone. Defs.' Mot. at 16; Defs.' Opp'n at 9. Defendants argue that Mr.
 4 Hillesland's changes were so trivial that even he could not determine whether printouts of
 5 visual images of a wishbone represented the wishbone before he made the changes or
 6 afterward. Rachman Decl., Ex. 4 (Hillesland Dep.) at 66:21-23, 67:11-68:8, 71:9-17, Exs.
 7 13, 14. Mr. Hillesland's testimony does not prove that his changes were trivial. Indeed, Mr.
 8 Hillesland's manual alterations to the electrodes consumed fifteen to twenty hours of his
 9 time, and his testimony regarding the hand-finishing of the electrodes shows that he
 10 expended significant effort to create a wishbone sculpture independent of the natural
 11 wishbone. Plaintiff has met its burden to show independent creation.

12 **ii. Minimal Creativity**

13 An original work must not only be independently created, but it also must "possess[]
 14 at least some minimal degree of creativity." Feist, 499 U.S. at 345. The Feist Court
 15 addressed "the requisite level of creativity," as follows:

16 [T]he requisite level of creativity is extremely low; even a slight amount will
 17 suffice. The vast majority of works make the grade quite easily, as they possess
 18 *some creative spark*, no matter how crude, humble or obvious it might be.
 19 Originality does not signify novelty; a work may be original even though it
 closely resembles other works so long as the similarity is fortuitous, not the
 result of copying.

20 Feist, 499 U.S. at 345 (internal citations and quotations omitted) (emphasis added). The
 21 Feist Court emphasized, however, that although "[t]he standard of originality is low, . . . it
 22 does exist." Id. at 362. "[A]n author who claims infringement must prove the existence of
 23 intellectual production, of thought, and conception." Id. (internal quotation and citation
 24 omitted).

25 Defendants argue that Lucky Break has offered contradictory arguments identifying
 26 the unique features of the Lucky Break Wishbone. Defendants point out that in Lucky

Break's initial responses to Defendants' Interrogatories, Lucky Break identified six allegedly original or creative elements in its wishbone. Rachman Resp. Decl., Ex. 16, at Interrog. No. 4 (describing Mr. Hillesland's artistic decisions), Interrog. No. 6 (six categories of "stylized accents"), and Interrog. No. 7 (referring back to Interrog. Nos. 4 and 6 in response to request to describe all "original or creative elements"); see also Ex. 4 (Hillesland Dep.) at 37:22-38:11, 43:3-48:7 (describing "five to six" changes). At the close of discovery, Lucky Break supplemented its responses to interrogatories with reports of two experts, each of whom assert between seven and eleven distinguishing features. Rachman Resp. Decl., Ex. 17 (Interrog. Nos. 4, 6, and 7); Rachman Decl., Ex. 32 (Mr. Sommer's Expert Report) at 7-11; Steadman Decl., Ex. A (Dr. Steadman's Expert Report) at 5-7. Regardless of the number, or identification, of original or creative elements, there are creative elements in the Lucky Break Wishbone as a result of Mr. Hillesland's manual alterations to the graphite electrodes. The evidence demonstrates that Lucky Break has met the "extremely low" standard for "minimal creativity." See Feist, 499 U.S. at 345. There is no requirement that "for valid copyright protection, the copyright must represent something entirely new under the sun." North Coast Indus., 972 F.2d at 1033. Plaintiff has met its burden to show the "minimal creativity" required for originality.

b. Validity (Utility) – Cross-Motions for Summary Judgment

As noted above, the Copyright Act protects "original works of authorship." 17 U.S.C. § 102(a). "Works of authorship include . . . sculptural works." Id. "[S]culptural works" include . . . three-dimensional works of fine, graphic, and applied art." Id. § 101(a). However, utilitarian aspects of sculptural works are not copyrightable:

Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article . . . shall be considered a . . . sculptural work only if, and only to the extent that, such design incorporates . . . sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

1 Id. The Ninth Circuit has recognized that animal mannequins painted, fitted with artificial
2 eyes, and covered with flocking are copyrightable. Rachel v. Banana Republic, Inc., 831
3 F.2d 1503, 1507 (9th Cir. 1987). “Where design elements can be identified as reflecting the
4 designer’s artistic judgment exercised independently of functional influences, conceptual
5 separability exists.” Brandir Int’l, Inc. v. Cascade Pac. Lumber Co., 834 F.2d 1142, 1145
6 (2d Cir. 1987); see also Kieselstein-Cord v. Accessories by Pearl, Inc., 632 F.2d 989, 993
7 (2d Cir. 1980) (finding sculptural element of belt buckle conceptually separable from
8 utilitarian function).

9 Defendants argue that Mr. Hillesland made changes to the graphite electrodes for
10 utilitarian purposes. Defendants selectively refer to the evidence to argue that Mr.
11 Hillesland’s changes were intended to make the Lucky Break Wishbone easier to handle or
12 to break. Although there is evidence that some changes may have, in fact, been made for
13 utilitarian reasons, the evidence is undisputed that other changes were made solely for
14 aesthetic or artistic reasons. See, e.g., Rachman Resp. Decl., Ex. 16 (Interrog. No. 4)
15 (describing Mr. Hillesland’s “artistic decisions”); Hillesland Decl. ¶ 5 (“I made these
16 changes [to the computer model] solely for aesthetic or artistic reasons”); id. ¶ 6 (“I made
17 choices . . . to make the final wishbone look better – sleeker and more attractive”); id. ¶ 7
18 (“My hand-working of the electrodes was always done with an eye towards shaping and
19 sculpting the part to fit my image of ‘the perfect wishbone’”); id. (“Most of the differences
20 between the original natural wishbone model and the Lucky Break Wishbone were both
21 deliberate and intended to make the Lucky Break Wishbone more appealing aesthetically.”).
22 Mr. Hillesland stated in his declaration that “none of the features discussed by Mr. Sommer
23 was required by the manufacturing process,” that “none was designed solely to serve a
24 practical or useful result,” and that “some features, such as the ridge, the valleys, and the
25 arrowhead shaped joint, were design[ed] solely for aesthetic reasons.” Id. ¶ 10. Mr.
26 Hillesland testified in his deposition that several design features – such as sanding down a

1 high spot at the bottom of the head and rounding the head – were made to achieve an
2 aesthetic result independent of any functional or manufacturing limitation. See, e.g., Walters
3 Resp. Decl., docket no. 106, Ex. E (Hillesland Dep.) at 43:17-24, 47:3-15. Plaintiff has met
4 its burden to show that some of the features of the Lucky Break Wishbone were made solely
5 for aesthetic or artistic reasons, independent of any utilitarian aspect.

6 **c. Conclusion Re: Validity Issues of Originality and Utility**

7 The Lucky Break Wishbone was independently created by Mr. Hillesland and
8 contains the minimal degree of creativity required to demonstrate originality. The design of
9 the Lucky Break Wishbone incorporates sculptural features that can be identified separately
10 from, and are capable of existing independently of, the utilitarian aspects of the article.
11 Accordingly, the Court GRANTS Plaintiff's summary judgment motion, and DENIES
12 Defendants' summary judgment motion, on the issues of originality and utility, and holds
13 that Lucky Break owns a valid copyright⁹ in the Lucky Break Wishbone. In other words,
14 both the prototype wishbone and production wishbone are "original works of authorship
15 fixed in any tangible medium of expression." See 17 U.S.C. § 102(a).

16 **2. Second Element of Copyright Infringement: Copying of Original Elements**

17 The second element of copyright infringement is "copying of constituent elements of
18 the work that are original." Feist, 499 U.S. at 361. "Because direct evidence of copying is
19 rarely available, a plaintiff may establish copying by circumstantial evidence of: (1)
20 defendant's access to the copyrighted work prior to the creation of defendant's work, and (2)
21 substantial similarity of both general ideas and expression between the copyrighted work and
22 the defendant's work." Baxter v. MCA, Inc., 812 F.2d 421, 423 (9th Cir. 1987); see also
23 Jada Toys, Inc. v. Mattel, Inc., 496 F.3d 974, 983 (9th Cir. 2007) ("[c]opying can be proved
24 by evidence indicating that the infringer had access to the copyrighted work and that the
25

26 ⁹ Again, the Court emphasizes that a valid copyright is different from a valid copyright registration.

protected portions of the works are substantially similar.”). Defendants have moved for summary judgment on the issues of access and substantial similarity.

a. Copying (Access) – Defendants’ Motion for Summary Judgment

As noted above, to prove copyright infringement, a copyright owner must demonstrate “defendant’s access to *the copyrighted work* prior to the creation of defendant’s work.” Baxter v. MCA, Inc., 812 F.2d at 423 (emphasis added). “Proof of access requires an opportunity to view or to copy plaintiff’s work.” Three Boys Music Corp. v. Bolton, 212 F.3d 477, 482 (9th Cir. 2000) (citation and internal quotation omitted). “Direct access” is shown if there is “proof that defendant actually viewed, read, or heard the work at issue.” 3 William F. Patry, Patry on Copyright, § 9:24, at 9-55 (2007). “[A] prior-created work cannot infringe a later-created one” because there can be no access to the copyrighted work. Christian v. Mattel, Inc., 286 F.3d 1118, 1128 (9th Cir. 2002) (“By simple logic, it is impossible to copy something that does not exist.”). In Christian v. Mattel, the allegedly infringing work was created six years before the allegedly infringed work, and the copyright infringement claim was held to be frivolous. 286 F.3d at 1128.

In the present case, the following facts are undisputed. Paraflex’s Mr. Hillesland completed the development of the Lucky Break *prototype* wishbone by January 27, 2004. Rachman Decl., Ex. 4 (Hillesland Dep.) at 25:10-20, 26:4-16, 51:19-22. Y&R purchased and received samples of Lucky Break’s wishbones in June and July 2005. Rachman Decl., Ex. 2 (Ahroni Dep.) at 80:10-24, 168:9-23; id., Ex. 6 (Navratil Dep.) at 52:23-53:18; id., Ex. 21 (Invoice to Y&R dated June 20, 2005). Y&R provided these wishbones to Sears in July 2005. Id., Ex. 6 (Navratil Dep.) at 62:9-12, 63:19-24; id., Ex. 7 (Katz Dep.) at 92:9-23. Sears, in turn, provided a Lucky Break wishbone to Apex in August 2005. Id., Ex. 8 (Chiou Dep.) at 39:18-40:2. Paraflex’s Mr. Hillesland completed the development of the Lucky Break *production* wishbone by the end of September 2005. Rachman Decl., Ex. 4 (Hillesland Dep.) at 51:23-52:19. Although the exact date of completion of the Sears

1 Wishbone is unknown, it was certainly completed by the time of the wishbone giveaway in
2 November 2005, and Lucky Break does not submit any evidence that Sears or Y&R had
3 access to the Lucky Break *production* wishbone prior to the creation of the Sears Wishbone.
4 Given this timing, the record clearly demonstrates, and Plaintiff does not dispute, that Sears
5 and Y&R had access only to Lucky Break's prototype wishbone, not to Lucky Break's
6 production wishbone, prior to the creation of the Sears Wishbone.

7 Sears and Y&R move for summary judgment based on their lack of access to Lucky
8 Break's production wishbone. Defendants, in essence, argue that the production wishbone is
9 the "copyrighted work" that Lucky Break's copyright infringement claim is based upon.
10 Defendants confuse the issue of copyright protection and copyright registration. While it is
11 true that Lucky Break only submitted a copy of the production wishbone as a deposit along
12 with its application for copyright registration, the prototype wishbone is nevertheless a
13 "copyrighted work." And there is no dispute that Defendants had access to the prototype
14 wishbone. Accordingly, the Court GRANTS IN PART Defendants' summary judgment
15 motion on the issue of access and DISMISSES IN PART Lucky Break's copyright
16 infringement claim – to the extent Lucky Break alleges that Defendants had access to and
17 copied the *production* wishbone. The Court DENIES IN PART Defendants' summary
18 judgment motion and holds that Lucky Break's copyright infringement claim survives
19 summary judgment – to the extent Lucky Break alleges that Defendants had access to the
20 *prototype* wishbone. See Second Am. Compl. ¶¶ 16-30.¹⁰

21
22 ¹⁰ As a result of Lucky Break's deposit of a copy of only the *production* wishbone with the
23 U.S. Copyright Office in connection with its application for copyright registration, the Court
24 is uncertain as to whether it has jurisdiction pursuant to 17 U.S.C. § 411(a) to entertain
25 Lucky Break's copyright infringement claim based on Sears' alleged infringement of Lucky
26 Break's copyright in the *prototype* wishbone. See Kodadek, 152 F.3d at 1211-12 (discussing
deposit requirement of 17 U.S.C. § 408(b)); Seiler v. Lucasfilm, Ltd., 808 F.2d 1316, 1322
(9th Cir. 1986) (same); Coles v. Wonder, 283 F.3d 798, 801-802 (6th Cir. 2002) (same); but
see 17 U.S.C. § 408(d) (addressing issue of supplementary registration); 37 C.F.R. § 201.5
(same).

b. **Copying (Similarities between Wishbones) – Defendants’ Motion for Summary Judgment**

i. **Lucky Break’s “Thin” Copyright**

Realistic depictions of live animals can be protected by copyright. Satava v. Lowry, 323 F.3d 805, 812 (9th Cir. 2003) (glass sculpture of jellyfish); Rachel, 831 F.2d at 1507 (animal mannequins); Kamar Int’l, 657 F.2d at 1061 (stuffed toy animals). However, “the scope of copyright protection in such works is narrow.” Satava, 323 F.3d at 812. To the extent the artistic choices are not governed by the animal’s physiology or by the medium of art, they are original elements that receive “thin” copyright protection. Id. Put another way, a thin copyright “compris[es] no more than [the artist’s] original contribution to ideas already in the public domain.” Id. In Satava, the Ninth Circuit held that the artist “may not prevent others from copying aspects of his sculptures resulting from either jellyfish physiology or from their depiction in the glass-in-glass medium.” Id. at 810. The Court concludes as a matter of law that Lucky Break’s copyright is “thin.” Lucky Break has also conceded that its copyright is “thin.” Rachman Decl., Ex. 1 (Transcript of Proceedings, Nov. 16, 2006) at 27:25 (Plaintiff’s counsel stating, “I will concede that this is a thin copyright.”).

ii. **“Virtually Identical” Test**

“Virtually identical,” not “substantially similar,” is the standard for determining whether a thin copyright has been copied, and thus infringed. Satava, 323 F.3d at 812 (quoting Ets-Hokin v. Skyy Spirits, Inc., 323 F.3d 763, 766 (9th Cir. 2003) (“When we apply the limiting doctrines, subtracting the unoriginal elements, Ets-Hokin is left with only a ‘thin’ copyright, which protects against only virtually identical copying”)); Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1439 (9th Cir. 1994) (“When the range of protectable and unauthorized expression is narrow, the appropriate standard for illicit copying is virtual identity.”).

1 In considering the similarities between works, the Ninth Circuit applies both an
2 extrinsic test and an intrinsic test. “[T]he extrinsic test . . . objectively considers whether
3 there are substantial similarities in both ideas and expression, whereas the intrinsic test . . .
4 measure[s] expression subjectively.” Apple Computer, 35 F.3d at 1442. The extrinsic test is
5 “based on external criteria; analytic dissection and expert testimony could be used.” Id. The
6 intrinsic test is a “test for similarity of expression from the standpoint of the ordinary
7 reasonable observer, with no expert assistance.” Id. The intrinsic test requires that the
8 work’s elements be viewed “as a whole.” Id. at 1443. Because “the intrinsic test is
9 inherently subjective,” it is “often inappropriate for summary judgment.” Express, LLC v.
10 Fetish Group, Inc., 424 F. Supp. 2d 1211, 1228 (C.D. Cal. 2006); see also Baxter, 812 F.2d
11 at 424-25 (reversing district court’s holding as a matter of law that there was no substantial
12 similarity between the two works, noting that “[d]eterminations of substantial similarity of
13 expression are subtle and complex”); Sid & Marty Krofft Television Prods., Inc. v.
14 McDonald’s Corp., 562 F.2d 1157, 1166 (9th Cir. 1977) (“the intrinsic test for expression is
15 uniquely suited for determination by the trier of fact”).

16 Defendants argue that the Sears Wishbone and the wishbone image in the Sears
17 Circular are not virtually identical to the Lucky Break *production* wishbone. This aspect of
18 the motion is rendered moot by the Court’s dismissal of Lucky Break’s copyright
19 infringement claim to the extent Lucky Break alleged infringement of the production
20 wishbone. Accordingly, the Court STRIKES IN PART Defendants’ summary judgment
21 motion on the issue of whether the Sears Wishbone and the wishbone image in the Sears
22 Circular are virtually identical to the Lucky Break *production* wishbone.

23 Defendants also argue that the Sears Wishbone and the wishbone image in the Sears
24 Circular are not virtually identical to the Lucky Break *prototype* wishbone. There are
25 genuine issues of material fact as to whether the Sears Wishbone and the wishbone image in
26 the Sears Circular are virtually identical to the Lucky Break *prototype* wishbone.

1 Accordingly, the Court DENIES IN PART Defendants' summary judgment motion on the
2 issue of whether the Sears Wishbone and the wishbone image in the Sears Circular are
3 virtually identical to the Lucky Break *prototype* wishbone.

4 **3. Copyright Infringement Claim Against Young & Rubicam – Defendants'**
5 **Motion for Summary Judgment**

6 Pursuant to this Order, the Court dismisses in part Lucky Break's copyright
7 infringement claim as alleged against both Defendant Sears and Defendant Young and
8 Rubicam (Y&R) – to the extent Lucky Break alleges that Defendants had access to the
9 *production* wishbone. The Court also holds that Lucky Break's copyright infringement claim
10 survives summary judgment to the extent Lucky Break alleges that Defendants had access to
11 and copied the *prototype* wishbone. Defendants argue that Lucky Break's copyright
12 infringement claim, Second Am. Compl. ¶¶ 29-30, should be dismissed in its entirety as to
13 Y&R because of Y&R's limited involvement in the allegedly infringing activities. The Court
14 agrees.

15 Defendants argue that Y&R is not liable for direct or contributory copyright
16 infringement. Plaintiff does not oppose Defendants' motion to dismiss Lucky Break's claim
17 of direct copyright infringement by Y&R. The only issue in debate then is whether Y&R is
18 liable for contributory copyright infringement. "One who, with knowledge of the infringing
19 activity, induces, causes or materially contributes to the infringing conduct of another may be
20 liable as a 'contributory' [copyright] infringer." Ellison v. Robertson, 357 F.3d 1072, 1076
21 (9th Cir. 2004) (quoting Gershwin Publ'g Corp. v. Columbia Artists Mgmt., Inc., 443 F.2d
22 1159, 1162 (2d Cir. 1971)). Thus, Lucky Break must show: (1) that Y&R "knew or had
23 reason to know of the infringing activity," and (2) that Y&R "materially contributed to the
24 infringing activity." See id. at 1077.

25 It is undisputed that Y&R, on behalf of its client Sears, negotiated with Lucky Break
26 over the terms of the purchase of 1 to 2 million Lucky Break Wishbones. Defendants argue

1 that negotiating, drafting, or holding agreements cannot form the basis for contributory
2 copyright infringement. Defendants rely on Calloway v. Marvel Entm't Group, 82 Civ. 8697
3 (RWS), 1983 U.S. Dist. LEXIS 10506, at ** 5-6 (S.D.N.Y. Dec. 22, 1983), in which the
4 Court held that a law firm, which negotiated, drafted and held agreements between plaintiff
5 and the alleged infringers, could not be held liable as a contributory infringer. Lucky Break
6 does not respond to Defendants' argument, thus impliedly conceding that the negotiations
7 between Y&R and Lucky Break cannot form the basis for contributory infringement.

8 Lucky Break asserts that numerous undisputed facts create an inference in its favor
9 that Y&R had knowledge of the infringing activity and/or materially contributed to the
10 alleged infringement. However, none of the facts, outlined below, are supported by any legal
11 authority as a basis for contributory copyright infringement.

12 First, Y&R conceived of the "Wish Big" campaign, one aspect of which included the
13 idea of the wishbone giveaway. Walters Resp. Decl., Ex. A (Katz Dep.) at 27-28, 42. The
14 general notion of a "Wish Big" campaign, and even the specific idea of giving away
15 wishbones, does not form a basis for contributory copyright infringement because these ideas
16 do not show Y&R's knowledge of, or involvement in, Sears's alleged copying of the Lucky
17 Break prototype wishbone.

18 Second, Y&R provided Lucky Break prototype wishbones to Sears, the alleged
19 infringer. Defendants point out, however, that Lucky Break provided the wishbones to
20 Y&R, and that Y&R, in turn, provided them to Sears under the authority of Lucky Break's
21 Mr. Ahroni. Mr. Ahroni's uncontradicted deposition testimony is as follows:

22 Q: Did you understand that Y&R was providing Sears with materials you
23 were providing to Y&R?

24 A: Presumably.

25 Q: So they had your authority to do that?

26 A: Yes.

1 Q: And did you understand that Y&R was providing to its client a Lucky
2 Break Wishbone itself?

3 A: Presumably.

4 Q: So they had your authority to do that as well?

5 A: Yes.

6 Rachman Decl., Ex. 2 (Ahroni Dep.) at 163:5-16. Defendants argue that merely providing
7 copyrighted work to an alleged infringer does not give rise to contributory liability.
8 Defendants rely on Herman Frankel Organization v. Tegman, 367 F. Supp. 1051, 1054 (E.D.
9 Mich. 1973), in which the Court dismissed a copyright claim as to two defendants who
10 procured copyrighted floor plans and gave them to another defendant who built a house
11 using a copy of the copyrighted floor plans. The Court dismissed the two “procurement”
12 defendants because they played no role in copying the plans. Id. Similarly here, Lucky
13 Break has failed to provide any evidence that Y&R played any role in the alleged copying of
14 the Lucky Break prototype wishbone by Sears, Apex and/or its Chinese manufacturer.
15 Lucky Break does not address Herman Frankel in its opposition brief. The undisputed facts
16 show that Y&R did not have any involvement with Apex regarding the manufacture of the
17 Sears Wishbone. Apex’s owner, Mr. Chiou, testified that he negotiated the manufacture of
18 the Sears Wishbone directly with former Sears’s employee Bob Pflanz, and that Apex never
19 had any conversations with Y&R and had not heard of Y&R prior to this lawsuit. Rachman
20 Decl., Ex. 8 (Chiou Dep.) at 25:15-26:3, 27:15-28:10, 45:23-48:10, 107:9-20. Moreover,
21 Y&R’s Ms. Navratil testified that she did not know who Mr. Pflanz (at Sears) was prior to
22 this lawsuit. Id., Ex. 6 (Navratil Dep.) at 115:23-116:10. There were no communications
23 between Y&R and the persons at Sears or at Apex who were involved with the manufacture
24 of the Sears Wishbone. Y&R’s provision of the Lucky Break prototype wishbones to Sears
25 does not form a basis of contributory copyright infringement.

26 Third, Y&R designed the packaging, namely the cardboard topper and the product
warning, to be used for the distribution of the Sears Wishbones. Walters Resp. Decl., Ex. A

1 (Katz Dep.) at 42-43, Ex. C (Navratil Dep.) at 70-71, 82-83. The product warning is the
2 subject of Plaintiff's new copyright infringement claim, see Second Am. Compl. ¶¶ 31-32,
3 and that alleged infringement is not presently before the Court.

4 Lucky Break's fourth factual basis for a contributory copyright infringement claim
5 against Y&R involves an email exchange. Lucky Break asserts that Y&R "worked with
6 ABD in the production of the 'front cover' of the infringing circular [i.e., the Sears
7 Circular]." Pl.'s Opp'n at 29:20-21 (citing Walters Resp. Decl., Ex. C (Navratil Dep.) at 91-
8 93). Y&R's Ms. Navratil was copied on an email dated July 20, 2005 from Phyllis Cohn at
9 ABD, and the email says "Is there any other element, other than the wishbone, that we
10 should incorporate into the front cover?" Walters Resp. Decl., Ex. C (Navratil Dep.) at 92:1-
11 93:16, Pl.'s Ex. 40 (email from ABD to Y&R). Although the email requests input, there is
12 no evidence that Y&R acted in any way in response to this email. When asked whether the
13 "ABD group was in charge of the creative side for the print ad," Ms. Navratil testified that
14 ABD group was "responsible for the circular." Id., Ex. C (Navratil Dep.) at 92:12-17. She
15 testified that the "circular" is "what ABD produces for Sears." Id., Ex. C (Navratil Dep.) at
16 92:24-93:1. She also testified that although Y&R "ha[s] contact with [ABD] . . . we don't
17 collaborate." Id., Ex. C (Navratil Dep.) at 98:10-16. In fact, Y&R did not see the Sears
18 Circular prior to its release. Rachman Decl., Ex. 6 (Navratil Dep.) at 43:22-44:8. Lucky
19 Break further asserts that as of July 20, 2005, Y&R knew that ABD needed a wishbone to
20 photograph for the Sears Circular sometime between August 26, 2005 and September 2,
21 2005. Id., Ex. C (Navratil Dep.) at 99, Pl.'s Ex. 41 (email from Y&R to Sears). As of July
22 20, 2005, however, Y&R was recommending that Lucky Break should be the vendor of
23 wishbones for the promotion, id., Ex. C (Navratil Dep.) at 99:12-100:1, Pl.'s Ex. 31
24 (showing that as late as Aug. 4, 2005, Y&R believed that Sears had approved Lucky Break).
25 Thus, no inference of infringement can possibly be made as a result of the July 20, 2005
26

1 email exchanges between Y&R and ABD's Phyllis Cohn, and between Y&R and Sears's Ms.
2 Katz.

3 In the absence of any evidence of direct or contributory copyright infringement by
4 Y&R, the Court GRANTS Defendants' summary judgment motion and DISMISSES Lucky
5 Break's copyright infringement claim as alleged against Y&R in the Second Amended
6 Complaint, ¶¶ 29-30.

7 **CONCLUSION**

8 The Court GRANTS the deferred portion of Plaintiff's summary judgment motion,
9 docket no. 84, and GRANTS IN PART, DENIES IN PART and STRIKES IN PART the
10 deferred portions of Defendants' summary judgment motion, docket no. 87, as follows:

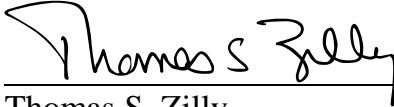
- 11 a. The Court GRANTS Plaintiff's summary judgment motion, and DENIES
12 Defendants' summary judgment motion, on the issues of originality and utility,
13 and holds that Lucky Break owns a valid copyright in both the Lucky Break
14 prototype wishbone and the Lucky Break production wishbone.
- 15 b. On the issue of access, the Court GRANTS IN PART and DENIES IN PART
16 Defendants' summary judgment motion. The Court GRANTS IN PART
17 Defendants' motion on the issue of access and DISMISSES IN PART Lucky
18 Break's copyright infringement claim – to the extent Lucky Break alleges that
19 Defendants had access to the *production* wishbone. The Court DENIES IN
20 PART Defendants' motion and holds that Lucky Break's copyright
21 infringement claim survives summary judgment – to the extent Lucky Break
22 alleges that Defendants had access to the *prototype* wishbone.
- 23 c. On the issue of whether the Sears Wishbone and the wishbone image in the
24 Sears Circular are virtually identical to the Lucky Break wishbones, the Court
25 STRIKES IN PART and DENIES IN PART Defendants' motion. The Court
26 STRIKES IN PART the motion as it relates to the production wishbone. The

1 Court DENIES IN PART the motion as it relates to the prototype wishbone
2 because of genuine issues of material fact.

- 3 d. On the issue of Y&R's infringement, the Court GRANTS Defendants'
4 summary judgment motion and DISMISSES Lucky Break's copyright
5 infringement claim as alleged against Y&R in the Second Amended Complaint,
6 ¶¶ 29-30.

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8 IT IS SO ORDERED.

9 DATED this 4th day of December, 2007.

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12 Thomas S. Zilly
13 United States District Judge
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